

ESTTA Tracking number: **ESTTA695370**

Filing date: **09/11/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	86251550
Applicant	IPA Holding, LLC
Applied for Mark	GENERATIONS SENIOR LIVING COMMUNITIES
Correspondence Address	THOMAS L LOCKHART VARNUM RIDDERING SCHMIDT & HOWLETT LLP PO BOX 352 GRAND RAPIDS, MI 49501-0352 UNITED STATES trademarks@varnumlaw.com
Submission	Appeal Brief
Attachments	Appeal Brief re GENERATIONS SENIOR LIVING COMMUNITIES.pdf(85987 bytes )
Filer's Name	Timothy Eagle
Filer's e-mail	teeagle@varnumlaw.com, trademarks@varnumlaw.com, brwal- ters@varnumlaw.com
Signature	/Timothy Eagle/
Date	09/11/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Mark: GENERATIONS SENIOR LIVING Serial No. 86251550  
COMMUNITIES Application Filing Date: April 14, 2014  
Applicant: IPA Holding, LLC  
Examining Attorney: Miroslav Novakovic  
Law Office 108

**EX PARTE APPEAL**

**APPLICANT'S BRIEF**

## **TABLE OF CONTENTS**

### **Page**

I.	PROSECUTION HISTORY.....	1
A.	OVERVIEW OF EXAMINING ATTORNEY'S POSITION SUPPORTING NFOA REFUSAL TO REGISTER MARK.....	1
B.	OVERVIEW OF APPLICANT'S RESPONSE TO NFOA IN SUPPORT OF REGISTRATION OF THE MARK .....	3
C.	OVERVIEW OF EXAMINING ATTORNEY'S POSITION SUPPORTING FOA REFUSAL TO REGISTER MARK.....	3
D.	OVERVIEW OF APPLICANT'S REQUEST FOR RECONSIDERATION AFTER FOA .....	4
E.	OVERVIEW OF EXAMINING ATTORNEY'S DENIAL OF REQUEST FOR RECONSIDERATION .....	5
II.	LEGAL ARGUMENT .....	5
III.	CONCLUSION.....	8

## **TABLE OF AUTHORITIES**

	<u>Page</u>
 <b><u>Cases</u></b>	
<i>Champagne Louis Roederer S.A. v. Delicato Vineyards</i> 148 F.3d 1373, USPQ2d 1459 (Fed. Cir. 1998) .....	6
<i>Han Beauty Inc. v. Alberto-Culver Co.</i> 236 F.3d 1333, 57 USPQ2d 1557 (Fed. Cir. 2001) .....	6
<i>In re AFG Industries</i> 17 USPQ2d 1162 (TTAB 1990) .....	6
<i>In re E.I. du Pont de Nemours &amp; Co.</i> 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) .....	6, 7
<i>In re the Estate of P.D. Beckwith, Inc. v. Commissioner of Patents</i> 252 U.S. 538, 40 S. Ct. 414, 64 L. Ed. 705 (1920) .....	6
<i>In re Majestic Distilling Co. Inc.,</i> 316 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) .....	6
<i>Recot, Inc. v. Becton</i> 214 F3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000) .....	6
 <b><u>Rules</u></b>	
TBMP § 1217.....	6
TMEP § 1207.01(b)(iii) .....	7
TMEP § 1207.01(d)(iii). .....	7

Applicant, IPA Holding, LLC, through the undersigned counsel, hereby respectfully appeals the Examining Attorney's refusal to register the mark GENERATIONS SENIOR LIVING COMMUNITIES.

**I. PROSECUTION HISTORY**

Applicant filed an application to register the mark GENERATIONS SENIOR LIVING COMMUNITIES ("Mark") with the United States Patent and Trademark Office ("USPTO" or "Office"). The application seeking registration of the Mark was filed April 14, 2014 ("Application"). The Examining Attorney initially refused to register the Mark in a Non-Final Office Action ("NFOA") on May 9, 2014. Applicant filed its response to the Examining Attorney's NFOA on November 10, 2014 ("Response"). Ultimately, the Examining Attorney refused to register the Mark in a Final Office Action ("FAO") on December 5, 2014, basing his refusal under Trademark Act Section 2(d) based upon a finding of likelihood of confusion with the marks in U.S. Registration Nos. 2847258, 3052038, and 3146205. Applicant timely filed its Notice of Appeal to the Trademark Trial and Appeal Board ("TTAB") on June 5, 2015.

**A. OVERVIEW OF EXAMINING ATTORNEY'S POSITION SUPPORTING NFOA REFUSAL TO REGISTER MARK**

The Examining Attorney refused to register the Applicant's Mark in an NFOA based upon on a finding under Section 2(d) of a likelihood of confusion with existing registrations for GENERATIONS MANAGEMENT, GENERATIONS REALTY, and GENERATION HOMES marks Nos. 2847258, 3052038, and 314625, respectively. In concluding a likelihood of confusion, the Examining Attorney determined that the Mark bore a similar appearance, sound, connotation, and impression to Nos. 2847258, 3052038, and 3146205 since the Mark and the other registered marks share the term "GENERATION(S)." The Examining Attorney also noted that consumers are inclined to focus on the first word in a trademark and that because the Mark

and the registered marks all begin with "GENERATION(S)," this increased the likelihood of confusion.

The registrants of the registered marks disclaimed the additional terms "MANAGEMENT," "REALTY," and "HOMES" as descriptions of their services whereas Applicant had not disclaimed "SENIOR LIVING COMMUNITIES." Since disclaimed terms are given less weight when comparing marks, the Examining Attorney determined that "GENERATION(S)" is the dominant portion of the marks.

The Examining Attorney further concluded that Applicant's services are similar and related to the registrants' services because the services all involve real estate activities. Applicant's services identified as "leasing of apartments; management of apartments" in International Class 36 and "real estate development" in International Class 37. The Examining Attorney found Applicant's Class 37 identification to be identical to GENERATION HOMES's identification and that the "real estate leasing and property management" services identified in GENERATIONS MANAGEMENT's mark encompassed Applicant's "leasing of apartments; managements of apartments" services in Class 36. Furthermore, the Examining Attorney concluded, GENERATIONS REALTY's "real estate brokerage" service is related to Applicant's "real estate development" and "leasing of apartments; management of apartments" services as such services are frequently offered together by the same entity in the real estate field.

The Examining Attorney also requested that Applicant disclaim the wording "SENIOR LIVING COMMUNITIES" because it describes only a feature of Applicant's services and an applicant may not claim exclusive rights to terms that are used in the marketplace to describe others' services. For those stated reasons, the Examining Attorney denied Applicant's registration.

**B. OVERVIEW OF APPLICANT'S RESPONSE TO NFOA IN SUPPORT OF REGISTRATION OF THE MARK**

In its Response to the NFOA, Applicant agreed to the disclaimer of "SENIOR LIVING COMMUNITIES" and further requested withdrawing the refusal, as the Mark does not run afoul of Section 2(d). Applicant maintained that the addition of registering the Mark would not lead to any confusion among consumers, as there are numerous third-party registrations which include "GENERATION(S)" that identify services as real estate development, real estate brokerage, and/or property management. Applicant included registrations for several of these marks, including NEW GENERATION REALTY and NEXT GENERATION FLAT FEE BROKER, and cited many other registrations. Since the public is inundated by third-party use of similar marks for similar services, Applicant argued that the Examining Attorney's cited marks are relatively weak and only entitled to a very narrow scope of protection.

Furthermore, Applicant responded, the focus on "GENERATION(S)" when comparing marks impermissibly analyzes the Mark in a piecemeal fashion. Applicant argued that such an analysis is entirely limited in scope when the Mark should be viewed in its entirety where it clearly does not create a likelihood of confusion in the marketplace.

**C. OVERVIEW OF EXAMINING ATTORNEY'S POSITION SUPPORTING FOA REFUSAL TO REGISTER MARK**

The Examining Attorney reiterated the same reasons for refusal from the NFOA in the FOA and addressed the arguments presented in Applicant's Response. The Examining Attorney stated that the weakness of a particular mark is usually determined by the number and nature of similar marks used in the marketplace. Third-party registrations, the Examining Attorney claimed, carry little weight in determining the strength of a mark because such registrations do not demonstrate that they are in actual use in the marketplace.

Furthermore, the Examining Attorney stated that several of the third-party marks that share "GENERATION(S)" contain additional non-descriptive terms such as "NEXT" and "NEW" that the Examining Attorney found to create a different commercial impression, which made them sufficiently distinct from other marks. Whereas the Examining Attorney stated "SENIOR LIVING COMMUNITIES," "MANAGEMENT," "REALTY," and "HOMES" are descriptive terms that create a similar commercial impression. Therefore, the Examining Attorney concluded that the Mark creates a likelihood of confusion and refused registration.

**D. OVERVIEW OF APPLICANT'S REQUEST FOR RECONSIDERATION AFTER FOA**

In its request for reconsideration of the FOA, Applicant indicated that it amended its claim of goods and services to remove International Class 37 to "real estate development," effectively removing it from the same class as the mark for GENERATION HOMES. GENERATION HOMES is not registered for the leasing of apartments or the management of apartments which is the only goods and services of Applicant's application. Applicant argued that because the services are not the same, there is no likelihood of confusion between GENERATION HOMES and Applicant's Mark.

Responding to the Examining Attorney's statement that it is difficult to determine whether third-party registrations are in use, Applicant also submitted new evidence that the marks NEW GENERATION REALTY and NEXT GENERATION FLAT FREE BROKERS are currently in use in the marketplace. Furthermore, Applicant argued, "NEW" and "NEXT" are commonly used within the class and should not provide any substantial weight in the registration of those marks. Applicant submitted a list of third-party registrations with the words "NEW" and "NEXT" to support this point.



**E. OVERVIEW OF EXAMINING ATTORNEY'S DENIAL OF REQUEST FOR RECONSIDERATION**

The Examining Attorney denied Applicant's request for reconsideration. In doing so, the Examining Attorney rejected Applicant's assertion that by removing the Class 37 services, there is no likelihood of confusion with GENERATION HOMES. The Examining Attorney stated that there is still the possibility of confusion despite the differences between the parties' services. Moreover, he concluded that the parties' services emanate from a single source under the same mark. Additionally, the Examining Attorney determined that Applicant's and registrants' services are provided through "the same trade channels and used by the same classes of consumers in the same fields of use" thereby making their services related.

The Examining Attorney further rejected Applicant's argument that NEXT GENERATION REALTY FLAT FEE BROKERS and NEW GENERATION REALTY are used in the marketplace thereby diluting the marks. Although they may be used in the marketplace, the Examining Attorney declared that marks deemed weak are still entitled to protection against subsequent registration of similar marks. Furthermore, the use of "NEXT" and "NEW" as the first words of the marks, the Examining Attorney found, distinguish them from other marks with "GENERATION(S)," thereby creating a different commercial impression, unlike the descriptive words found in Applicant's and registrants' marks.

**II. LEGAL ARGUMENT**

The Application stands refused as to goods in International Class 36 on the basis of alleged likelihood of confusion with the marks in U.S. Registration Nos. 2847258, 3052038, and 3146205 under Trademark Act § 1052(d) and TMEP §§ 1207.01 *et seq.* On appeal, the TTAB reviews the decision of the examining attorney to determine if it was correctly made. TBMP

§ 1217; *In re AFG Industries*, 17 USPQ2d 1162, 1163 (TTAB 1990). Applicant appeals from the refusal for the reasons set forth below.

The Court of Customs and Patent Appeals in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) enumerated the factors to be weighed in a Section 2(d) likelihood of confusion analysis. When conducting its likelihood of confusion analysis, the TTAB must consider all *du Pont* factors for which there is evidence in the record. *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). The *du Pont* factors to be considered include the similarity or dissimilarity of the marks in their entireties. *In re E.I. du Pont de Nemours & Co.*, 177 USPQ at 567; *See also In re Majestic Distilling Co. Inc.*, 316 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). Each case must be decided on its own facts and any one *du Pont* factor may be dispositive. *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998).

In essence, the position taken in the FOA violates the anti-dissection rule by breaking up Applicant's Mark into component parts and comparing only certain of the component parts to the cited mark. Applicant's Mark should be considered in its entirety. *In re the Estate of P.D. Beckwith, Inc. v. Commissioner of Patents*, 252 U.S. 538, 545-46, 40 S. Ct. 414, 64 L. Ed. 705 (1920). It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion. It is improper to dissect conflicting marks to determine if the commercial impressions are confusing. *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000).

It is sometimes noted that if the dominant portion of two marks is the same, then confusion may be likely, notwithstanding peripheral differences. That proposition does not apply where the marks in their entireties convey significantly different commercial impressions. TMEP

§ 1207.01(b)(iii). Considering the overall commercial impression of Applicant's Mark, it is respectfully submitted that there is no likelihood of confusion with respect to the goods in International Class 36.

Taking the Mark as a whole, there are no registered marks that are substantially similar to "GENERATIONS SENIOR LIVING COMMUNITIES." There are no registered marks that use the word GENERATIONS in the context of a retirement community, nursing home, or other senior living community. Applicant acknowledges that if there were registered marks for "GENERATIONS RETIREMENT COMMUNITY" or "GENERATIONS NURSING HOME," for example, that those marks would be likely to be confused with the Applicant's Mark. However, "GENERATIONS SENIOR LIVING COMMUNITIES" creates a different commercial impression than "GENERATIONS MANAGEMENT," "GENERATIONS REALTY," OR "GENERATION HOMES."

Furthermore, weakness of a mark is determined by the number and nature of similar marks currently in use in the marketplace. *In re E.I. du Pont de Nemours & Co*, 177 USPQ at 567. The fact that there are three cited registrations and numerous other registrations which include "GENERATION(S)" as applied to real estate development, real estate brokerage, and property management services demonstrates that the public is exposed to third-party use of similar marks. This exposure is relevant to show that the cited marks are weak and diluted, entitled only to a narrow scope of protection. TMEP § 1207.01(d)(iii). Applicant has adequately shown that similar marks other than the three cited registrations are used in the marketplace in connection with similar services thereby diluting the marks. Since the public is already subject to marks containing similar language and related to similar services, it is respectfully submitted that there is no likelihood of confusion.

### **III. CONCLUSION**

For the foregoing reasons, Applicant respectfully requests that the TTAB reverse the FOA and order registration of the Mark.

Respectfully submitted,

VARNUM, RIDDERING, SCHMIDT  
& HOWLETT LLP  
Attorneys for Appellant

Dated: September 11, 2015

By: /s/ Timothy Edward Eagle  
Timothy Edward Eagle  
Business Address and Telephone:  
Bridgewater Place, P.O. Box 352  
Grand Rapids, Michigan 49501-0352  
(616) 336-6000  
[teeagle@varnumlaw.com](mailto:teeagle@varnumlaw.com)

### **CERTIFICATE OF SERVICE**

I hereby certify that on September 11, 2015, a copy of the foregoing was filed electronically.

VARNUM, RIDDERING, SCHMIDT  
& HOWLETT LLP  
Attorneys for Appellant

Dated: September 11, 2015

By: /s/ Timothy Edward Eagle  
Timothy Edward Eagle  
Business Address and Telephone:  
Bridgewater Place, P.O. Box 352  
Grand Rapids, Michigan 49501-0352  
(616) 336-6000  
[teeagle@varnumlaw.com](mailto:teeagle@varnumlaw.com)

9748531\_1.docx